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Dated: July 23, 2004 Signature: _____ (Marcus J. Millet)

EXPEDITED PROCEDURE
Docket No.: TRANS 3.0-038A
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Harhen et al.	
Application No.: 09/904,963	Group Art Unit: 3737
Filed: July 13, 2001	Examiner: E. Mantis-Mercader
For: ENERGY APPLICATION WITH INFLATABLE ANNULAR LENS	

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MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

Dear Sir:

The present communication is responsive to the Official Action mailed February 26, 2004. A petition for a two-month extension of the term for response to said Official Action, to and including July 26, 2004, is transmitted herewith. Claims 1-12 were previously presented and have not been amended. A notice of appeal is also transmitted herewith.

Claims 1-12 of the present application were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent 6,938,792 to *O'Connor* in view of *Fjield, et al.*, U.S. Patent Application Publication No. 2003/0050632 A1 ("*Fjield* '632"). Applicants respectfully traverse this rejection, because *Fjield* '632 is not prior art upon which a § 103(a) rejection can be based.

For a reference to be valid as prior art under § 103(a), it must fall within one of the categories of prior art defined in § 102. The priority date of the present application

is before the publication of *Fjield* '632, which means that the reference cannot fall within §§ 102(a) or (b). *Fjield* '632 does not qualify as prior art under § 102(e) because it and the present application both claim the benefit of Provisional Application No. 60/218,641. The effective filing date of the reference is not before the effective filing date of the present application. Furthermore, the named inventors of the present application are identical to those of the *Fjield* '632 publication. For that reason as well, *Fjield* '632 is not prior art under § 102(e), which requires that the reference be "by another." Thus, *Fjield* '632 is clearly outside the scope of available prior art under § 102 and, accordingly, may not be used as part of an obviousness rejection under § 103(a). It is, therefore, respectfully requested that the § 103(a) rejection of claims 1-12 be withdrawn.

Claims 1-12 of the present application have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting based on U.S. Application No. 09/925,227 ("the '227 application"). Applicants respectfully traverse this provisional rejection. The '227 application has now issued as U.S. Patent No. 6,635,054 ("the '054 patent"). A terminal disclaimer was previously transmitted with Applicants' response of December 4, 2003 to the Official Action dated June 4, 2003 in which the same rejection was made. As previously stated, the terminal disclaimer in the present application as to the '054 patent is believed to obviate the obviousness-type double patenting rejection on the basis of the '054 patent and on the basis of the '227 application. It is, therefore, respectfully requested that the obviousness type double patenting rejection based on the '054 patent be withdrawn.

Claims 1-12 were further rejected under the judicially created doctrine of obviousness-type double patenting based upon

"claims 1-4" of U.S. Application No. 10/062,693, which has issued as U.S. Patent No. 6,672,312 ("the 312 patent"), and which contains only three claims. Reconsideration and withdrawal of this rejection are respectfully requested. Applicants assert that the Examiner has not provided evidence necessary to make out a *prima facie* case of double patenting. Specifically, M.P.E.P. § 804(B)(1) requires that:

> Any obviousness-type double patenting rejection should make clear:
>
> (A) the differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
>
> (B) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

The Examiner has not directly compared the claims of the present application to those of the '312 patent and has not given any reasons why the claims of the present application represent an obvious variation of the claims in the '312 patent. It is, therefore, respectfully requested that the obviousness-type double patenting rejection of claims 1-12 of the present application on the '312 patent be withdrawn.

Additionally, the obviousness-type double patenting rejection is believed to be substantively incorrect. That is, the subject matter of claims 1-12 inclusive is not believed to be obvious in light of the subject matter in claims 1-3 of the '312 patent. Although M.P.E.P. § 804(B)(1) allows consideration of the portions of the disclosure of the cited reference that pertain to the invention claimed, the disclosure of the reference may not be used as prior art. The proper use of the written description is limited to that of a dictionary to learn the meaning of a term in the claims, and for other similar

explanation of the scope of the claims. M.P.E.P. § 804(B)(1) (citing *In re Vogel*, 422 F.2d 438, 441-41, 164 U.S.P.Q. 619, 622 (CCPA 1970)).

Claims 1-3 of the '312 patent are directed to methods involving locating myocardial fibers within a pulmonary vein and ablating regions of the vein containing the myocardial fibers, the ablated region being "less than one half the circumference of said pulmonary vein." These methods may involve the use of an imaging technique (claim 2) or, more specifically, the use of magnetic resonance imaging ("MRI") (claim 3) to locate the myocardial fibers to be ablated.

In making the comparison required by M.P.E.P. § 804(B)(1), it is clear that the claims of the present application are not an obvious variation of the claims of the '312 patent. The claims of the present application are directed toward an apparatus for applying ultrasonic energy to tissue comprising an ultrasonic emitter and an inflatable lens (claims 1-8), and a method for applying ultrasonic energy to tissue using the same (claims 9-12). In both instances, the inflatable lens surrounds the ultrasonic emitter such that it focuses the ultrasonic waves from the emitter into an annular focal region. Nothing claimed in the '312 patent has been asserted as suggesting the use of an inflatable lens surrounding the emitter or the use of such a lens to focus of ultrasonic waves from an emitter into an annular focal region.

Looking only to the invention claimed in the '312 patent, as is appropriate in this instance, there is nothing to indicate that it would be an obvious variation of the '312 patent to ablate tissue in accordance with the method claimed therein by using an ultrasonic emitter in combination with an inflatable lens surrounding the emitter. Therefore, the claims of the present invention are patentably distinct from the claims of the '312 patent, and represent more than obvious variations

thereof. Accordingly, Applicants respectfully request that the obviousness-type double patenting rejection of claims 1-12 of the present application on the '312 patent be withdrawn.

As it is believed that all of the rejections set forth in the Official Action have been fully met by the foregoing response, favorable reconsideration and allowance of the present claims are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: July 23, 2004

Respectfully submitted,

By_____

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